

REMARKS

Claims 1-23 are pending in this application. Claims 1, 8, and 20 are independent. In light of the amendments and remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this Amendment, Applicant has amended claims 1 and 8 to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected Claims 1-4 and 17-19 under 35 U.S.C. §102(e) as being anticipated by *Arai et al.* (USP 6,775,361); Claim 5 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Tanaka et al.* (U.S. Patent Application Publication No. 2002/0191096); Claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Tanaka et al.* and further in view of *Kiyokawa* (USP 6,204,877); Claims 8-10, 12, 16, and 20-23 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Fumio et al.* (USP 6,515,706); Claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Fumio et al.* and further in view of *Oeda et al.* (U.S. Patent Application Publication No. 2001/0012071); Claim 13 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Fumio et al.* and further in view of *Tanaka et al.*; and Claims 14-15 under 35 U.S.C. §103(a) as being unpatentable over *Arai et al.* in view of *Fumio et al.* and *Tanaka et al.* and further in view of *Kiyokawa*. Applicant respectfully traverses these rejections.

Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner rejects claim 1 asserting the teachings of *Arai et al.* anticipate the claim features. Specifically, the Examiner asserts that *Arai et al.* discloses a mode setting device (mode selection switch 431 of Fig. 10) that sets a first mode (telephone) and a second mode (camera). The Examiner further asserts that *Arai et al.* discloses a controlling device that prohibits the electronic device from performing camera functions when the first mode is set by the mode-

setting device (citing to col. 8, lines 25-27, disclosing an operation mode for turning off the camera unit). Applicant respectfully disagrees with the Examiner's assertions.

The disclosure of *Arai et al.* is directed to a recording/playback apparatus with telephone, video camera with telephone and image communication functionality. Specifically, at col. 7, line 66 through col. 8, line 28, Arai et al. discloses as follows:

Upon receiving a call by access from the radio public network or the partner station during image sensing by the operator, the video camera with telephone operates in accordance with a **call reception mode** and a **video camera operation mode** of the video camera main body 300 with telephone, which are set by the operator.

The video camera operation mode is selected from a-1: no mode change, and a-2: pause image recording. If a-1 is selected, no mode change is made; if a-2 is selected, the control enters an image recording pause mode. The call reception mode is selected from b-1: normal call reception, and b-2: image recording call reception. If b-1 is selected, normal call reception proceeds, i.e., an alerting bell, vibrator, LED, or the like functions; if b-2 is selected, image recording call reception proceeds, and the call reception function is stopped if it may disturb normal image recording. The call reception function that may disturb normal image recording includes sound produced by the alerting bell, vibration generated by the alerting vibrator, and a light source such as the call reception LED.

In case of image recording call reception, a call reception message is displayed on the display 305. At this time, the telephone number of the calling party, video information, importance level of the access purpose, subject matter, and the like are additionally displayed. Furthermore, as the **video camera operation mode**, other operation modes such as a stop mode, and the like, a **mode of turning off the video camera unit**, and the like may be added. Also, as the call reception mode, a call reception deny mode, transfer mode, automatic answering mode, and the like may be added. (emphasis added)

In contrast, the present invention set forth in claim 1 recites, *inter alia*, an electronic device comprising a mode setting switch that sets one of a first mode for a function which is unrelated to camera functions and a second mode which is related to camera functions; and a controlling device that prohibits the electronic device from performing camera functions whenever the first mode is set by the mode setting device.

However, based upon the above disclosure, the mode of turning off the video camera unit relates to the video camera operation mode, not the telephone mode. This setting is not associated with, nor dependent upon, the mode setting switch 431 of Fig. 10, as relied upon by the Examiner. Further, the mere teaching of providing for an operation mode for turning off the video camera unit is insufficient to teach or suggest “prohibiting the electronic device from performing camera functions” as the user is still able to turn the video camera on. In other words, the telephone mode of *Arai et al.* is a mode in which its operation unit, such as the keypad 10 and the dial, functions as a means for operating the telephone, and a camera mode of *Arai et al.* is a mode in which the aforementioned operation unit functions as a means for operating the camera. Further, *Arai et al.*'s device comprises a camera function and a communication function such as a videophone and the images taken by the camera are transmitted to the receiver with audio. As such, since *Arai et al.*'s communication function transmits images taken by the camera function, *Arai et al.*'s communication function is related to the camera function.

Based upon the above, it is respectfully submitted that *Arai et al.* fails to teach or suggest a controlling device that prohibits the electronic device from performing camera functions whenever the first mode is set by the mode setting device. As *Arai et al.* fails to teach or suggest all of the claim elements, it is respectfully submitted that claim 1 is not anticipated by *Arai et al.* It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-7 are allowable for the reasons set forth above with regard to claim, at least based upon their dependency on claim 1.

Claims Rejections Under 35 U.S.C. § 103 - *Arai et al./Fumio et al.*

In support of the Examiner's rejection of claims 8 and 20, the Examiner relies on the teachings of *Arai et al.* as set forth above with regard to claim 1. However, as noted above with regard to claim, *Arai et al.* fails to teach or suggest the controlling device as set forth in claim 8 and further fails to teach or suggest wherein the first mode of operation provides a function

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unrelated to functions of a digital camera as recited in claim 20. As *Fumio et al.* fails to cure the deficiencies of the teachings of *Arai et al.*, assuming these references are properly combinable, which Applicant does not admit, it is respectfully submitted that these claims, together with claims dependent thereon, are not obvious over the references as cited by the Examiner. It is respectfully requested that the outstanding rejection be withdrawn.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By

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